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	all correspondence after initial filin	Attorney Docket Number	2178 Gregory	/ J. Vaughn
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rwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number Complete if Known Effective on 12/08/2004. Fouant to the Consolidated Appropriations Act, 2005 (H.R. 4818). 09/636.418 Application Number **TRANSMITTAL** August 10, 2000 Filing Date For FY 2005 Christopher E. Axe First Named Inventor Gregory J. Vaughn **Examiner Name** Applicant claims small entity status. See 37 CFR 1.27 Art Unit 2178 (\$) 500.00 TOTAL AMOUNT OF PAYMENT Attorney Docket No. PA2378US METHOD OF PAYMENT (check all that apply) Check Money Order None Other (please identify): Deposit Account Name: Carr & Ferrell LLP Deposit Account Deposit Account Number: 06-0600 For the above-identified deposit account, the Director is hereby authorized to: (check all that apply) Charge fee(s) indicated below Charge fee(s) indicated below, except for the filing fee Charge any additional fee(s) or underpayments of fee(s) Credit any overpayments under 37 CFR 1.16 and 1.17 WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038. **FEE CALCULATION** 1. BASIC FILING, SEARCH, AND EXAMINATION FEES **FILING FEES SEARCH FEES EXAMINATION FEES Small Entity** Small Entity **Small Entity** Fees Paid (\$) **Application Type** Fee (\$) Fee (\$) <u>Fee (\$)</u> Fee (\$) Fee (\$) Utility 300 150 500 200 100 250 200 Design 100 100 50 130 65 Plant 200 100 300 150 160 80 300 Reissue 500 600 150 250 300 Provisional 200 100 0 0 2. EXCESS CLAIM FEES **Small Entity** Fee (\$) Fee Description Fee (\$) Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent 25 Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent 200 100 180 Multiple dependent claims **Total Claims Multiple Dependent Claims** Fee (\$) Fee Paid (\$) - 20 or HP = Fee Paid (\$) Fee (\$) HP = highest number of total claims paid for, if greater than 20 Extra Claims Fee Paid (\$) - 3 or HP = HP = highest number of independent claims paid for, if greater than 3 3. APPLICATION SIZE FEE If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s). Number of each additional 50 or fraction thereof **Total Sheets Extra Sheets** Fee Paid (\$) (round up to a whole number) x - 100 = 4. OTHER FEE(S) Fees Paid (\$) Non-English Specification, \$130 fee (no small entity discount) Appeal Brief filing fee Other: 500

SUBMITTED BY			
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UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.

09/636,418

Conf. No. 6284

Applicants

Christopher E. Axe et al.

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Filed

August 10, 2000

Art Unit

2178

Examiner

Gregory J. Vaughn

Title

Visual Configurator

Docket No.

PA2378US (formerly 4876)

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BRIEF ON APPEAL

Sir:

This brief is submitted in an Appeal from the Final Office Action of 01/27/2005 (paper 20) rejecting Claims 1-35 of the above-referenced patent application.

(1) Real Party in Interest

The real party in interest in the above-referenced patent application is Peoplesoft, Inc. of Pleasanton, California.

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(2) Related Appeal and Interferences

To the knowledge of Applicants' legal representative, there are no related appeals or interference proceedings which will directly affect, or be directly affected by, or have a bearing on, the Board's decision in this Appeal.

(3) Status of Claims

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Claims 1-35 are pending in this application.

Claims 1-3, 6-9, 14-17, 23-30, and 32-34 were rejected under 35 U.S.C. 102(b) as being anticipated by Henson, US Patent 6,167,383 (filed 09/22/1998).

Claims 4, 5, 11-13 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson.

Claims 10, 21, 22, 31 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of King et al., US Patent 6,161,114 (filed 4/14/1999).

(4) Status of Amendments

Claims 1-15 were included in the application as filed. Claims 16-33 were added by amendment filed March 24, 2004. The Examiner entered this Amendment. Claims 34-35 were added by amendment filed September 15, 2004. The Examiner entered this Amendment. No further claim amendments have been submitted.

(5) Summary of the Claimed Subject Matter

The present invention is directed to systems and methods of visually configuring a product in a graphical user interface, examples of which are illustrated in FIGs. 2 through 7. In various embodiments, the invention provides for a user to select one of a plurality of objects (e.g., FIG. 2 items 210-230) that can be placed in a plurality of slots (e.g., FIG. 2 items 252-285). Once an object is selected there is more than one slot in which it can be placed. The selection and placement can occur through a drag-and-drop process in which immediate feedback is provided regarding the ability to drop a selected object in a particular slot.

The feedback is optionally provided before or while the object is being placed in a selected slot. For example, FIGs. 3 through 6 show a drag-and-drop process that is discussed in part on page 9 line 1 through page 10 line 3, and page 16 lines 3-18 (page numbers refer to the application as filed). In this example, the immediate feedback is shown as a large "X" (Item 410) in FIG. 4, and, as described on page 13 lines 10-18, this "X" appears as the user is dragging the object over a particular slot, prior to placement of the object in the slot.

is actually placed in a slot because embodiments of the invention include forward-looking rules tables and a user intelligence for generating the feedback. The forward-looking rules tables are described, for example, on

The immediate feedback can be provided before a selected object

page 10 line 16 through page 13 line 4. The user intelligence is

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characterized, and contrasted with "server side intelligence," for example, on page 10 lines 4-18.

The visual configuration layout is optionally representative of the actual physical layout of the product. For example, FIGs. 2 through 7 represent the actual physical layout of an electronics rack (Equipment Frame) and the displayed positions of slots within this rack are representative of actual physical slots within the rack.

(6) Grounds of Rejection to be Reviewed on Appeal

Issue 1: Whether Claims 1-3, 6-9, 14-17, 23-30, and 32-34 were properly rejected under 35 U.S.C. 102(b) as being anticipated by Henson, US Patent 6,167,383 (filed 09/22/1998).

Issue 2: Whether Claims 4, 5, 11-13 and 18-20 were properly rejected under 35 U.S.C. 103(a) as being unpatentable over Henson.

Issue 3: Whether Claims 10, 21, 22, 31 and 35 were properly rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of King et al. US Patent 6,161,114 (filed 4/14/1999).

(7) Grouping of Claims

For each ground of rejection which Appellants contest herein which applies to more than one claim, such additional claims, to the extent separately identified and argued below, do not stand or fall together.

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(8) Argument

Issue 1: Whether claims 1-3, 6-9, 14-17, 23-30, 32 and 33 were properly rejected under 35 U.S.C. 102(b) as being anticipated by Henson, US Patent 6,167,383, filed 09/22/1998.

Under 35 U.S.C. 102(b) "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

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Regarding Claim 1.

Claim 1 recites:

- A method for visually configuring a product by placing a plurality of selectable components into a plurality of slots, comprising:
 - (a) initializing a configuration layout with proper state;
 - (b) receiving a selection of one of the plurality of selectable objects, and of one of the plurality of slots in which the selected object may be placed;
 - (c) providing visual feedback indicating a validity of the selections;
- 20 (d) receiving a placement of the selected object;
 - (e) receiving input regarding the placement from a remote inference engine;
 - (f) updating the visual feedback as needed based on the received input; and
 - (g) repeating steps (b) through (f) until no more selections are received.

A. It is the position of the Applicants that the cited art does not teach "(d) receiving a placement of the selected object." In this claim limitation, a placement of a previously selected object is received.

Henson teaches selection of an item, already located within a field, from a pull-down menu. For example, in FIGs. 3A-3B, Henson teaches a series of fields for configuring a computer system. Each field appears to include a dropdown list of items that can be selected. As such, each item (e.g., 96 MB SDRAM or 16.8GB 5400rpm Ultra ATA Hard Drive, etc.) appears to be located within one particular field prior to selection. There is, therefore, no reason for Henson to teach a separate placement of a selected item because the item is already within its field.

Furthermore, even if, for the sake of argument, it were assumed that the selection of an item from a dropdown list of <u>Henson</u> anticipates "(b) receiving a **selection** of one of the plurality of selectable objects," there does not appear to be a separate teaching of receiving of a **placement** of the selected object.

Because, in <u>Henson</u>, the selected item is located within a field prior to selection, there is no reason for a placement of the selected item to be sent or received following the selection. Thus, the Applicants are unable to find teaching of both a "selection" and a separate "placement of the selected object" in <u>Henson</u>.

In contrast with the teachings of <u>Henson</u>, Claim 1 recites both a "selection" and a "placement" of an object. Specifically, Claim 1 recites both "(b) receiving a selection of one of the plurality of selectable objects" and "(d) receiving a placement of the selected object" as two separate steps. The "selection" is distinct from the separate "placement." Specifically, the "selection" is received in step "(b)" of Claim 1, while the "placement" is received in separate step "(d)."

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Therefore, it is the position of the Applicants that the cited art does not teach the limitations "receiving a placement of the selected object," as recited in Claim 1.

B. It is the position of the Applicants that the cited art does not teach "(b) receiving a selection of one of the plurality of selectable objects, and of one of the plurality of slots in which the selected object may be placed." In these claim limitations, the phrase "in which the selected object may be placed" characterizes "the plurality of slots." Thus, a selected object may be placed in one of a plurality of alternative slots.

While, <u>Henson</u> does teach a plurality of fields and a plurality of items to be selected within each field, this teaching does not anticipate the above limitations. Specifically, in <u>Henson</u> a selected item cannot be placed in one of a plurality of alternative fields. For example, <u>Henson</u> does not appear to teach that the "96MB SDRAM" (FIG. 3A) could be placed alternatively in the "Monitor" field or the "Speakers" field. In <u>Henson</u> one cannot select an item from a drop-down list within one field in order to place that item in another field. This would be contrary to the well known functionality of drop-down lists. Thus, even though there are a plurality of fields taught in Henson, only a <u>single</u> member of this plurality is available to an item that has been selected. There are not a "plurality of slots in which the selected object may be placed."

The Applicants are unable to identify any teaching within <u>Henson</u> that suggests that a user can "place" or "move" an item to alternative fields. Each selected item taught in <u>Henson</u> is already located within a single field (i.e., not a plurality of fields) and cannot be placed in another field after selection. Thus,

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Henson does not teach "one of a <u>plurality</u> of slots in which the selected object may be placed," as recited in Claim 1.

Even if, arguendo, one were to assume that <u>Henson</u> teaches placement of a selected item in a slot, there is only a single slot into which a selected item can be placed, not a "plurality of slots in which the selected object may be placed," as recited in Claim 1. Again, while it remains Applicants' position that this is not placement of a selected item, a selected item can only be placed within the slot with which it resided prior to its selection. Thus, the Applicants are unable to identify any teaching in <u>Henson</u> that would imply that this placement is in "one of a plurality of slots in which the selected object may be placed," as recited in Claim 1.

C. The Examiner has suggested that "receiving a placement of the selected object" included ambiguous language because it was not clear what a "placement" was. The Applicants believe that this language is not ambiguous in light of the plain meaning of the word "placement" and of the use of the word "placement" in the specification as filed. For example, FIGs. 3-7 show a process by which an object is dragged across a graphical user interface and placed in a slot. Therefore, it is the Applicants' position that the specification properly characterizes the term "placement," that this characterization is consistent with the plain meaning, and that given this characterization the wording of the claim is not ambiguous. The American Heritage® Dictionary of the English Language, Fourth Edition defines "placement" as "a) the act of placing or arranging, or b) the state of being placed or arranged."

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- **D.** Because at least the above limitations of Claim 1 are not taught in the cited art, it is the position of the Applicants that the Examiner has not presented a prima facie case for rejection of Claim 1 under 35 U.S.C. 102(b) and that Claim 1, and those claims that depend therefrom, are in condition for allowance.
- E. The Applicants note that the above arguments also apply to independent Claims 2, 12, 14, 15, and 16.

Regarding Claim 2.

Claim 2 recites:

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- 2. A method for visually configuring a product by placing a plurality of selectable components into a plurality of slots, comprising:
 - (a) initializing a configuration layout with proper state;
 - (b) receiving a selection of one of the plurality of selectable objects, and of one of the plurality of slots in which the selected object may be placed;
 - (c) looking up a set of constraints on the placement of the selected object;
 - (d) receiving a placement of the selected object;
 - (e) receiving input regarding the placement from a remote inference engine;
 - (f) implementing the received input;
 - (g) storing a new set of constraints based on the placement of the selected object; and
 - (h) repeating steps (b) through (g) until no more selections are received.
 - **A.** It is the Applicants' position that Claim 2 is allowable for the same reasons discussed above with respect to Claim 1. Specifically, <u>Henson</u> does not teach "(b) ... one of a plurality of slots in which the selected object may be placed," or "(d) receiving a placement of the selected object."
 - **B.** In addition, it is the position of the Applicants that the cited art does not teach "(g) storing a new set of constraints," much less that the stored "constraints farel based on the placement of the selected object," as recited in Claim 2."

It is the position of the Applicants that "constraints" are rules regarding, for example, what objects can be combined in a product. For example, "constraints" are rules that are either violated or not violated. See, for example, page 13 line 19 of the specification as filed.

Henson does teach saving a shopping cart containing items selected for purchase. For example, at col. 10 lines 52-54, Henson teaches "A user can place an item into the cart, back out of the store, re-enter and place another item in the cart..." However, the Applicants are unable to identify any teaching within Henson that constraints, much less a new set of constraints associated with placement of a selected item, are included in the saved cart. Items selected for purchase are not constraints because, among other reasons, they are not rules that can be considered to be violated or not violated. Therefore, a teaching that a shopping cart including items for purchase can be saved does not teach "storing a new set of constraints" as recited in Claim 2.

C. Because at least the above limitations of Claim 2 are not taught in the cited art, it is the position of the Applicants that the Examiner has not presented a prima facie case for rejection of Claim 2 under 35 U.S.C. 102(b) and that Claim 2 is in condition for allowance.

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Regarding Claims 3 and 6-8.

A. It is the Applicants' position that Claims 3 and 6-8 are in condition for allowance for at least the same reasons discussed above with respect to Claim 2, from which they depend.

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Regarding Claim 9.

Claim 9 recites:

9. A system for visually configuring a product from a plurality of selectable components, comprising:

a user interface for displaying the plurality of selectable components and a plurality of slots into which the plurality of selectable components can be placed; and

a user intelligence communicatively coupled to the user interface, for receiving a set of constraints from a remote inference engine and implementing the set of constraints.

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A. It is the Applicants' position that Claim 9 is in condition for allowance for at least reasons discussed above with respect to Claim 1. For example, <u>Henson</u> does not teach "a plurality of slots into which the plurality of selectable components can be placed."

B. It is further the position of the Applicants that the cited art does not teach "a user intelligence communicatively coupled to the user interface, for receiving a set of constraints from a remote inference engine," The term "user intelligence" refers to logic that is on a side of a client-server architecture remote from the inference engine, and is used to distinguish this logic from "server side intelligence." For example FIG. 1 illustrates an embodiment in which "User intelligence 140" includes "Forward-looking rules table Storage 150," "Forward-looking rules implementor 155," "Forward-looking rule table Interpretor 145," and

"Encoder of implementation 160." The Applicants are unable to identify any similar teaching in the cited art.

In rejecting Claim 9 the Examiner states "Henson discloses a user intelligence (described as 'user input') coupled to a user interface...," (01/27/05 Office Action at page 21). The Applicants traverse this statement.

First, it is improper to equate an implied <u>human</u> user of the system of <u>Henson</u> with an element of the claimed system.

Second, the "user intelligence" included in Claim 9, and other claims, is characterized by the specification to have features (e.g., those shown in FIG. 1) that would not normally be included in input received from a human user. Thus, equating "user intelligence" with a user's input is an interpretation of "user intelligence" that is inconsistent with the specification.

C. Because at least the above limitations of Claim 9 are not taught in the cited art, it is the position of the Applicants that the Examiner has not presented a prima facie case for rejection of Claim 9 under 35 U.S.C. 102(b) and that Claim 9 is in condition for allowance.

Regarding Claim 14.

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A. It is the Applicants' position that Claim 14 is in condition for allowance for at least the same reasons discussed above with respect to Claim 1.

Regarding Claim 15.

A. It is the Applicants' position that Claim 15 is in condition for allowance for at least the same reasons discussed above with respect to Claim 2.

5 Regarding Claim 16.

Claim 16 recites:

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- 16. A method of visually configuring a product by placing one or more of a plurality of objects into one or more slots, subject to a plurality of configuration rules, the method comprising:
 - (a) providing the plurality of objects and a predetermined product configuration layout to a client device for display within a graphical user interface, the product configuration layout including the one or more slots;
 - (b) receiving, from the client device, a selection of one of the plurality of objects displayed within the graphical user interface and a selection of one of the one or more slots, the selection of the one of the plurality of objects and the selection of one of the one or more slots being for modification of the product configuration layout;
 - (c) causing the graphical user interface to indicate that the selected object cannot be placed in the selected slot, if placing the selected object in the selected slot would violate one or more of the plurality of configuration rules; and
 - (d) causing the graphical user interface to show the selected object within the selected slot, if placing the selected object in the selected slot would not violate any of the plurality of configuration rules.
- A. It is the Applicants' position that Claim 16 should be allowed for at least reasons similar to those discussed above with respect to Claim 1. Specifically, Henson does not teach "slots in which the selected object may be placed," (Claim 1) and therefore does not teach "indicat[ing] that the selected object cannot be placed in the selected slot" (Claim 16).
- **B.** It is the Applicants' position that <u>Henson</u> does not teach "(c) causing the graphical user interface to indicate that the selected object cannot be placed

in the selected slot, if placing the selected object in the selected slot would violate one or more of the plurality of configuration rules," as recited in Claim 16.

Henson does teach an indication that a selection is incompatible <u>after</u> an item has been chosen within a field. See, for example, reference sign 86 of FIG. 3A. That this indication is provided after a user has already taken the trouble of choosing an item already within a field is a significant disadvantage of <u>Henson</u>.

In contrast with the teachings of <u>Henson</u>, the indications recited in the above claim elements occur prior to or during an attempted placement of "the selected object" in "the selected slot." This is supported by the language "<u>if</u> placing the selected object in the selected slot <u>would</u>" in Claim 16. The words "<u>if</u>" and "would" characterize determination of consequences of a future action. An advantage of the indication as recited in Claim 16 is seen in FIGs. 3 and 6 of the specification, wherein the indication is provided while a user is dragging a selected object toward a slot but before the object is dropped (e.g., placed) in the slot.

C. Because at least the above limitations of Claim 16 are not taught in the cited art, it is the position of the Applicants that the Examiner has not presented a prima facie case for rejection of Claim 1 under 35 U.S.C. 102(b) and that Claim 16, and Claims 17-23 and 35 that depend therefrom, are in condition for allowance.

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Regarding Claim 17.

A. It is the Applicants' position that Claim 17 should be allowed for at least the same reasons discussed above with respect to Claim 16 from which it depends.

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Regarding Claim 23.

Claim 23 recites:

23. The method of claim 16 wherein the configuration layout is representative of a physical layout of the product.

A. It is the position of the Applicants that Henson does not teach "wherein the configuration layout is representative of a physical layout of the product."

Henson does teach the selection of physical items, e.g., memory and hard drives, and these items are presented in a list on a user interface. Henson also shows a generic image of a computer in the upper left hand corner of FIG. 3A.

However, the Applicants are unable to identify any indication that these teachings represent "a physical layout of the product." First, FIG. 3A of Henson shows configuration elements in the following order "Memory," "Hard Drive," "Monitor," "Video Card" "CD-Rom Drive," "Sound Card," "Speakers," "Storage Products," etcetera. There is no teaching within Henson that this order is a representation of the physical order or spatial relationship of these elements in the computer product being purchased. It is the Applicants' position that arranging these elements in this order within a computer would be a nonfunctional arrangement.

Second, the Applicants are unable to find any teaching that the generic image shown in the upper left hand corner of FIG. 3A is anything more than a generic and static representation of a computer unrelated to any particular physical configuration or selections made elsewhere in FIG. 3A. For example, there does not appear to be any teaching that the image changes in response to changes in the physical layout as a consequence of user selections. In addition, several options do not appear to be represented in this image (e.g., the Memory, Hard Drive, Video Card, Video Card and Speakers). Further, those options that are shown in the image do not seem to be in the order suggested by the order of configuration elements. For example, in the image, it appears that there is a hard drive at the top of the computer tower, while the Hard Drive option is second in the order of configuration elements.

Third, while <u>Henson</u> teaches individual physical elements of a product, e.g., "96 MB SDRAM," the common usage of the term "layout" refers to more than a single physical object. Specifically, layout refers to the spatial arrangement or positioning of a set of objects. For example, The American Heritage Dictionary of the English Language, Fourth Edition defines *layout* as "[a]n arrangement or a plan, especially the schematic arrangement of parts or areas."

B. Because at least the above limitations of Claim 23 are not taught in the cited art, and for at least the reasons discussed with respect to Claim 16, it is the position of the Applicants that the Examiner has not presented a prima facie case

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for rejection of Claim 23 under 35 U.S.C. 102(b) and that Claim 23 is in condition for allowance.

Regarding Claim 24.

5 Claim 24 recites:

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24. A method of visually configuring a product by placing one or more of a plurality of objects into a slot, the method comprising:

providing a product configuration layout to a client device for display within a graphical user interface, the product configuration layout including a slot for placement of one of the plurality of objects;

providing the plurality of objects to the client device for display within the graphical user interface;

receiving, from the client device, a selection of one of the plurality of selectable objects for placement within the slot;

causing the graphical user interface to show the selected selectable object within the slot if the selected object can be placed in the slot without violating a configuration rule; and

causing the graphical user interface to indicate that the selected object cannot be placed in the slot, if placing the selected object in the selected slot would violate the configuration rule.

A. It is the Applicants' position that Claim 24 is in condition for allowance for at least reasons similar to those discussed above with respect to Claims 1 and 16.

B. It is the Applicants' position that the cited art does not teach "causing the graphical user interface to indicate that the selected object cannot be placed in the slot, if placing the selected object in the selected slot would violate the configuration rule."

Henson does teach at FIG. 3A reference sign 86 an indication that a current selection of an item violates a constraint.

However, an indication that a current configuration is in violation of a constraint is not equivalent to an indication "that the selected object cannot be placed in the slot, if placing the selected object in the selected slot would violate the configuration rule." First, as recited in Claim 24, the indication occurs before or during an attempted placement of the object in the slot. Second, the indication occurs prior to, rather than after, violation of the configuration rule.

Third, as illustrated in FIG. 3A of <u>Henson</u> the item is already in the field when the indication is displayed to a user. In contrast, according to Claim 24 "the selected object cannot be placed in the slot." The claim limitation that "the selected object cannot be placed in the slot" is not taught by FIG. 3A of <u>Henson</u> which shows an indication where an item is **in the field**. In fact, because <u>Henson</u> shows the item in the field and Claim 24 recites that "the selected object cannot be placed in the slot," the teaching of <u>Henson</u> is in direct contradiction with these limitations of Claim 24.

C. Because at least the above limitations of Claim 24 are not taught in the cited art, it is the position of the Applicants that the Examiner has not presented a prima facie case for rejection of Claim 24 under 35 U.S.C. 102(b) and that Claim 24 is in condition for allowance.

Regarding Claims 25-27.

A. It is the Applicants' position that Claims 25-27 are in condition for allowance for at least the reasons discussed above with respect to Claim 24, from which they depend.

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Regarding Claim 28.

A. It is the Applicants' position that Claim 28 is in condition for allowance for at least the reasons discussed above with respect to Claim 24, and also Claim 23.

Regarding Claim 29.

Claim 29 recites:

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29. A method of configuring a product for purchase, the method comprising: selecting the product for purchase, the product having a plurality of alternative configurations, the plurality of alternative configurations being limited by a plurality of configuration rules;

viewing a first configuration of the plurality of alternative configurations and a plurality of objects, within a graphical user interface, the viewed first configuration including one or more slots within which at least one of the plurality of objects may be placed;

specifying a second configuration of the selected product by selecting a first of the plurality of objects for placement in a first of the one or more slots, the placement of the first of the plurality of objects in the first of the one or more slots being limited by a subset of the plurality of configuration rules, the selection of the first of the plurality of objects being made using the graphical user interface.

A. It is the Applicants' position that Claim 29 is in condition for allowance
for at least reasons similar to those discussed above with respect to Claim 1.

Specifically, <u>Henson</u> does not teach "slots within which at least one of the plurality of objects may be placed," and "selecting a first of the plurality of objects for placement in a first of the one or more slots."

B. It is the Applicants' position that the cited art does not teach "specifying a second configuration of the selected product by selecting a first of the plurality of objects for placement in a first of the one or more slots," much less where "the

placement of the first of the plurality of objects in the first of the one or more slots being <u>limited by a subset of the plurality of configuration rules</u>." The Applicants are unable to identify any teachings in <u>Henson</u> that are interpretable as teaching these limitations.

With regard to Claim 29, the Examiner states "Henson discloses in Figure 3A, at reference sign 75 a subset of the configuration rules, in response to the selection of an object (as shown at reference sign 77)." Reference sign 75 is directed at what appears to be a generic textual description of the configuration category "Hard Drive," while reference sign 77 is directed at what appears to be a configuration category "Memory" including a selected option "96MB SDRAM." It is not clear to the Applicants how this teaches "a subset of the plurality of configuration rules," as suggested by the Examiner. The referenced figure elements do not appear to be configuration rules much less a subset of configuration rules. Further, the reference items do not appear to be in response to "selecting a first of the plurality of objects for placement in the first of the one or more slots," as recited in Claim 29.

C. Because at least the above limitations of Claim 29 are not taught in the cited art, it is the position of the Applicants that the Examiner has not presented a prima facie case for rejection of Claim 29 under 35 U.S.C. 102(b) and that Claim 29, and Claims 30-31 which depend therefrom, are in condition for allowance.

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Regarding Claim 30.

Claim 30 recites:

30. The method of claim 29, wherein the subset of the plurality of configuration rules is determined based on the first configuration.

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A. It is the Applicants' position that Claim 30 is in condition for allowance for at least the reasons discussed above with reference to Claim 29. Specifically, the Applicants are unable to identify any teaching within <u>Henson</u> concerning determination of a "subset" of configuration rules, much less a teaching that this determination is "based on the first configuration." The Examiner has not responded to requests to point out such teaching or allow Claim 30.

B. Because at least the above limitations of Claim 30 are not taught in the cited art, it is the position of the Applicants that the Examiner has not presented a prima facie case for rejection of Claim 30 under 35 U.S.C. 102(b) and that Claim 30 is in condition for allowance.

Regarding Claim 32.

A. It is the Applicants' position that Claim 32 is in condition for allowance for at least the reasons discussed above with respect to Claim 29, and also Claim 17.

Regarding Claim 33.

A. It is the Applicants' position that Claim 33 is in condition for allowance for at least the reasons discussed above with respect to Claim 1.

Issue 2: Whether Claims 4, 5, 11-13 and 18-20 were properly rejected under 35 U.S.C. 103(a) as being unpatentable over Henson.

Under 35 U.S.C. 103(a), the scope and content of the prior art are to be determined, and the differences between the prior art and the claims at issue are to be ascertained. See <u>Graham v. John Deere</u>, 383 US 1, 148 USPQ 459 (1966).

Regarding Claims 4 and 5.

Claim 4 recites:

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4. The method of claim 2, wherein the step of looking up constraints comprises looking up a forward-looking rules table.

Claim 5 recites:

15 5. The method of claim 4, wherein the step of storing a new set of constraints comprises storing a new forward-looking rules table.

A. It is the Applicants' position that Claims 4 and 5 are in condition for allowance for at least the reasons discussed above with respect to Claim 2, from which they depend.

B. It is the Applicants' position that the cited art does not teach a "forward-looking rules table."

Henson does teach the use of configuration conflicts and it is suggested by the Examiner that these conflicts are responsive to a table of rules. However, in <u>Henson</u> configuration conflicts are detected <u>after</u> they occur. Any rules that are applied are looking back at the last change in configuration. See for

example, item 86 on FIG. 3A of <u>Henson</u>. These rules are, therefore, "backward-looking" rather than "forward-looking," as recited in Claims 4 and 5.

There is a substantial difference between <u>forward-looking</u> rules as recited in Claims 4 and 5, and <u>backward-looking</u> rules as are suggested to be taught by <u>Henson</u>. The Applicants provided an example of the characteristics of "forward-looking rules table," in the specification as filed:

"[F]orward-looking rules table [of the invention] is created based on the components selected by the user, and their placements. Based on each new selection an placement by a user, a new forward-looking rules table is created which lists the constraints on the *next* selection by the user. That is, the forward-looking rules table identifies which slots may or may not be occupied by which particular objects in the next selection by the user. (specification as filed page 11, emphasis in original).

In pointing out this text the Applicants are not attempting to read limitations from the specification into the claims. Rather, the Applicants are attempting to clarify the meaning of "forward-looking rules table," as recited in Claims 4 and 5, and elsewhere.

In contrast, any rules taught in <u>Henson</u> appear to be backward-looking rules because they detect conflicts after they occur. The Applicants are unable to find any teaching in <u>Henson</u> of constraints being applied "forward," that is, before a configuration change has been made. It is, therefore, the Applicants' position that the constraints taught in <u>Henson</u> are not forward-looking. There would, therefore, be no reason in <u>Henson</u> to employ a "forward-looking rules table" as recited in Claims 4 and 5.

Applicants note that the above arguments also apply to at least Claims 11, 12 and 18.

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C. For at least the above reasons, it is the Applicants' position that Claims4 and 5 are in condition for allowance.

Regarding Claim 11.

5 Claim 11 recites:

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- 11. The system of claim 9, wherein the user intelligence comprises:
 an interpretor for receiving a set of constraints from an inference engine;
 a storage for storing the set of constraints;
 an implementor for implementing the forward-looking rules stored in the table; and
 - an encoder for encoding and sending data regarding a user's current selection from the plurality of donors and the plurality of receptors to the inference engine.
- **A.** It is the Applicants' position that Claim 11 is in condition for allowance for at least the same reasons as Claims 4 and 5 as discussed above, as well as Claim 9 from which it depends.
- **B.** It is further the Applicants' position that the cited art does not teach "interpertor," "implementor," or "encoder" recited in Claim 11. The Applicants are unable to identify any such teaching and the Examiner has not pointed out specific sections of <u>Henson</u> that he believes teach these elements of Claim 11.
- C. For at least the above reasons, it is the Applicants' position that Claim11 is in condition for allowance.

25 **Regarding Claim 12.**

Claim 12 recites:

12. A system for visually configuring a product from a plurality of selectable components, comprising:
on a client device:

a visual user interface for displaying the plurality of selectable components and a plurality of slots into which the plurality of selectable components can be placed;

a user intelligence communicatively coupled to the visual user interface for determining, by using a forward-looking rules table, the validity of placement of one of the plurality of selectable components into one of the plurality of slots; and on a remote host device:

an inference engine communicatively coupled to the user intelligence, for storing rules and constraints governing placement of the plurality of selectable components, and for generating the forward-looking rules table.

A. It is the Applicants' position that Claim 12 is in condition for allowance for at least the reasons discussed above with respect to Claims 1, 4, 5 and 9.

Specifically, Claim 12 includes "a plurality of slots," "a forward-looking rules table," and "a user intelligence" not taught by the cited art."

Regarding Claim 13.

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A. It is the Applicants' position that Claim 13 is in condition for allowance for at least the reasons discussed above with regard to Claim 12.

Regarding Claim 18:

A. It is the Applicants' position that Claim 18 is in condition for allowance
for at least the reasons discussed above with respect to Claim 16, and also
Claims 4 and 5.

Regarding Claim 19:

Claim 19 recites:

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19. The method of claim 16 wherein a user intelligence stored on the client device is used to determine if placing the selected object in the selected slot would violate one or more of the plurality of configuration rules.

A. It is the Applicants' position that Claim 19 is in condition for allowance for at least the reasons discussed above with respect to Claim 16 from which it depends, and also Claims 4, 5. Specifically, the cited art does not teach "a user intelligence."

B. It is the Applicants' position that Claim 19 is in condition for allowance because the prior art does not teach a "user intelligence" that is "stored on the client device." The Applicants are unable to find any teachings within the cited art of these limitations.

C. It is the Applicants' position that Claim 19 is in condition for allowance for reasons similar to those discussed above with respect to Claim 24.

Specifically, the cited art does not teach a determination that occurs prior to an actual violation of a configuration rule or during at attempted violation of a configuration rule.

D. For at least the above reasons, it is the Applicants' position that Claim 19 is in condition for allowance.

Regarding Claim 20.

It is the Applicants' position that Claim 20 is in condition for allowance for at least the reasons discussed above with regard to Claim 16. Issue 3: Whether Claims 10, 21, 22 and 31 were properly rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of King et al. US Patent 6,161,114 (filed 4/14/1999).

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Regarding the Motivation to Combine.

It is the position of the Applicants' that the Examiner has not provided sufficient motivation for the combination of <u>King</u> and <u>Henson</u>. With respect to the combination the Examiner states on page 17 of the January 27, 2005 office action:

[I]t would have been obvious, to one of ordinary skill, at the time the invention was made, to use the drag and drop teachings of King to enhance the object selection function of Henson to allow user the ability to "improve document production" (King, Column 6, line 7).

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The only suggestion of a motivation provided by the Examiner is, thus, "to 'improve document production." However, "improved document production" is not related to the claimed invention nor is it a goal of <u>Henson</u>. Therefore, one of ordinary skill in the art would not think to combine <u>Henson</u> and <u>King</u> to achieve such an objective. Therefore, this motivation does not support the combination of art as suggested by the Examiner under 35 U.S.C. 103(a). Without providing a proper motivation to combine, the Examiner has failed to make a prima facie case for a rejection under 103(a). (See <u>Graham v. John Deere</u>, 383 US 1, 148 USPQ 459 (1966) and <u>In re Linter</u>, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).)

Regarding Claim 10.

A. It is the position of the Applicants that Claim 10 is in condition for allowance for at least the reasons discussed above with respect to Claim 9, from which it depends.

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Regarding Claim 22.

Claim 22 Recites:

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22. The method of claim 16 wherein the selection of one of the plurality of objects and the selection of one of the one or more slots includes dragging the one of the plurality of objects to the one of the one or more slots within the graphical user interface, and wherein causing the graphical user interface to indicate that the selected object cannot be placed in the selected slot includes not allowing the dragged one of the plurality of objects to be dropped in the one of the one or more slots.

- **A.** It is the position of the Applicants that Claim 22 is in condition for allowance for at least the reasons discussed above with respect to Claim 16, from which it depends.
- B. It is the position of the Applicants that the cited art does not teach
 "wherein causing the graphical user interface to indicate that the selected object cannot be placed in the selected slot includes not allowing the dragged one of the plurality of objects to be dropped in the one of the one or more slots," as recited in Claim 22. The Applicants have requested that the Examiner specifically point out these teachings in the cited art or allow Claim 22, however the Examiner has failed to cite specific examples. Rather, in the Office Action of 01/27/2005 (page 16) the Examiner made general statements regarding

dependent Claims 10, 21, 22 and 31, without addressing the limitations, such as those above, that are unique to Claim 22.

C. For at least the above reasons, it is the position of the Applicants that Claim 22 is in condition for allowance.

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Regarding Claims 21 and 31.

A. It is the Applicants' position that Claims 21 and 31 are in condition for allowance for at least the reasons discussed above with regard to Claims 16 and 29 from which they depend, respectively.

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Regarding Claim 35.

Claim 35 recites:

35. The method of claim 16, wherein causing the graphical interface to indicate that the selected object cannot be placed in the selected slot occurs while attempting to place the selected object in the selected slot.

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A. It is the position of the Applicants that Claim 35 is in condition for allowance for at least the reasons discussed above with respect to Claim 16, from which it depends.

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B. Further it is the position of the Applicants that the cited art does not teach "causing the graphical interface to indicate that the selected object cannot be placed in the selected slot occurs while attempting to place the selected object in the selected slot," as recited in Claim 35.

In the Office Action of 01/27/2005, the Examiner stated "[r]egarding claim 35, the claim is directed toward [a] method for the system of claim 10 and is

rejected using the same rationale," (page 17). In response, the Applicants pointed out that Claim 35 includes limitations, such as "while attempting to place the selected object in the selected slot," that are not found in Claim 10. The Applicants also requested that the Examiner point out teachings of these limitations within the cited art or allow Claim 35. The Examiner has not responded to this request except to refer to his original statement.

C. For at least these reasons the Applicants believe that Claim 35 is in condition for allowance.

For all the foregoing reasons, it is requested that the Board of Patent Appeals and Interferences reverse the rejections of the Examiner regarding Claims 1-35 so that this case may be allowed and pass to issue in a timely

Respectfully submitted, Christopher E. Axe et al.

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manner.

Date: June 24, 2005

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Appendix I

Claims:

1	1. (Original) A method for visually configuring a product by placing a plurality of
2	selectable components into a plurality of slots, comprising:
3	(a) initializing a configuration layout with proper state;
4	(b) receiving a selection of one of the plurality of selectable objects, and of
5	one of the plurality of slots in which the selected object may be
6	placed;
7	(c) providing visual feedback indicating a validity of the selections;
8	(d) receiving a placement of the selected object;
9	(e) receiving input regarding the placement from a remote inference
10	engine;
11	(f) updating the visual feedback as needed based on the received input;
12	and
13	(g) repeating steps (b) through (f) until no more selections are received.
1	2. (Original) A method for visually configuring a product by placing a plurality of
2	selectable components into a plurality of slots, comprising:
3	(a) initializing a configuration layout with proper state;
4	(b) receiving a selection of one of the plurality of selectable objects, and of
5	one of the plurality of slots in which the selected object may be
6	placed;
7	(c) looking up a set of constraints on the placement of the selected object;

8	(a) receiving a placement of the selected object,
9	(e) receiving input regarding the placement from a remote inference
10	engine;
11	(f) implementing the received input;
12	(g) storing a new set of constraints based on the placement of the
13	selected object; and
14	(h) repeating steps (b) through (g) until no more selections are received.
1	3. (Original) The method of claim 2, further comprising:
2	transmitting information regarding the placement of the object to the
3	inference engine.
1 2	4. (Original) The method of claim 2, wherein the step of looking up constraints comprises looking up a forward-looking rules table.
1	5. (Original) The method of claim 4, wherein the step of storing a new set of
2	constraints comprises storing a new forward-looking rules table.
1 2	6. (Original) The method of claim 2, wherein the input is received from an inference engine.
1	7. (Original) The method of claim 2, wherein the selection of one of the plurality
2	of selectable objects, and of a slot in which the selected object may be
3	placed, is received via a user interface.

l	8. (Original) The method of claim 2, wherein the received input is implemented in
2	a user interface.

- 9. (Original) A system for visually configuring a product from a plurality of 1 2 selectable components, comprising: a user interface for displaying the plurality of selectable components and a 3 plurality of slots into which the plurality of selectable components 4 5 can be placed; and a user intelligence communicatively coupled to the user interface, for 6 receiving a set of constraints from a remote inference engine and 7 implementing the set of constraints. 8
- 10. (Original) The system of claim 9, wherein the visual user interface comprises: 1 2 donors depicting the plurality of selectable components; receptors depicting the plurality of slots into which the donors can be 3 4 placed;
- a graphical manipulation enabler for implementing drag and drop behavior of the donors into the receptors; and a configuration conflicts displayer, for updating a visual display responsive 7
- to at least one of the plurality of donors being put into at least one 8 of the plurality of slots such that at least one constraint stored on 9 10 the user intelligence is violated.
 - 11. (Original) The system of claim 9, wherein the user intelligence comprises:

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2	an interpretor for receiving a set of constraints from an inference engine;
3	a storage for storing the set of constraints;
4	an implementor for implementing the forward-looking rules stored in the
5	table; and
6	an encoder for encoding and sending data regarding a user's current
7	selection from the plurality of donors and the plurality of receptors
8	to the inference engine.
1	12. (Original) A system for visually configuring a product from a plurality of
2	selectable components, comprising:
3	on a client device:
4	a visual user interface for displaying the plurality of selectable
5	components and a plurality of slots into which the plurality of
6	selectable components can be placed;
7	a user intelligence communicatively coupled to the visual user
8	interface for determining, by using a forward-looking rules
9	table, the validity of placement of one of the plurality of
10	selectable components into one of the plurality of slots; and
11	on a remote host device:
12	an inference engine communicatively coupled to the user
13	intelligence, for storing rules and constraints governing
14	placement of the plurality of selectable components, and for
15	generating the forward-looking rules table.

1	13. (Original) The system of claim 12, wherein the client device further
2	comprises a web browser which is communicatively coupled to the
3	remote host device via a network service.
	44 (O initial) A supporter program ambadied in a tangible modium and
1	14. (Original) A computer program embodied in a tangible medium and
2	capable of being executed by a computer for performing a method
3	for visually configuring a product by placing a plurality of selectable
4	components into a plurality of slots, comprising:
5	(a) initializing a configuration layout with proper state;
6	(b) receiving a selection of one of the plurality of selectable objects, and o
.7	one of the plurality of slots in which the selected object may be
8	placed;
9	(c) providing visual feedback indicating a validity of the selections;
10	(d) receiving a placement of the selected object;
11	(e) receiving input regarding the placement from a remote inference
12	engine;
13	(f) updating the visual feedback as needed based on the received input;
14	and
15	(g) repeating steps (b) through (f) until no more selections are received.
1	15. (Original) A computer program embodied in a tangible medium and capable
2	of being executed by a computer for performing a method for visually
3	configuring a product by placing a plurality of selectable components into
4	a plurality of slots, comprising:

5	(a) initializing a configuration layout with proper state;
6	(b) receiving a selection of one of the plurality of selectable objects, and of
7	one of the plurality of slots in which the selected object may be
8	placed;
9	(c) looking up a set of constraints on the placement of the selected object;
10	(d) receiving a placement of the selected object;
11	(e) receiving input regarding the placement from a remote inference
12	engine;
13	(f) implementing the received input;
14	(g) storing a new set of constraints based on the placement of the
15	selected object; and
16	(h) repeating steps (b) through (g) until no more selections are received.
1	16. (Previously Presented) A method of visually configuring a product by placing
2	one or more of a plurality of objects into one or more slots, subject to a
3	plurality of configuration rules, the method comprising:
4	(a) providing the plurality of objects and a predetermined product
5	configuration layout to a client device for display within a graphical
6	user interface, the product configuration layout including the one or
7	more slots;
8	(b) receiving, from the client device, a selection of one of the plurality of
9	objects displayed within the graphical user interface and a selection
10	of one of the one or more slots, the selection of the one of the

11	plurality of objects and the selection of one of the one or more slots
12	being for modification of the product configuration layout;
13	(c) causing the graphical user interface to indicate that the selected object
14	cannot be placed in the selected slot, if placing the selected object
15	in the selected slot would violate one or more of the plurality of
16	configuration rules; and
17	(d) causing the graphical user interface to show the selected object within
18	the selected slot, if placing the selected object in the selected slot
19	would not violate any of the plurality of configuration rules.
1	17 (Proviously Proported) The method of claim 16, wherein the plurality of
1	17. (Previously Presented) The method of claim 16, wherein the plurality of
2	configuration rules allow a finite number of valid product configuration
3	layouts.
1	18. (Previously Presented) The method of claim 16 wherein a forward-looking
2	rules table is used to determine if placing the selected object in the
3	selected slot would violate one or more of the plurality of configuration
4	rules.
1	19. (Previously Presented) The method of claim 16 wherein a user intelligence
2	stored on the client device is used to determine if placing the selected
3	object in the selected slot would violate one or more of the plurality of
4	configuration rules.

- 20. (Previously Presented) The method of claim 16 wherein an inference engine
 on a server is used to determine if placing the selected object in the
 selected slot would violate one or more of the plurality of configuration
 rules, the server being configured for receiving the selection of one of the
 plurality of objects.
- 21. (Previously Presented) The method of claim 16 wherein the selection of one of the plurality of objects and the selection of one of the one or more slots includes dragging the one of the plurality of objects to the one of the one or more slots within the graphical user interface.
- 22. (Previously Presented) The method of claim 16 wherein the selection of one of the plurality of objects and the selection of one of the one or more slots includes dragging the one of the plurality of objects to the one of the one or more slots within the graphical user interface, and wherein causing the graphical user interface to indicate that the selected object cannot be placed in the selected slot includes not allowing the dragged one of the plurality of objects to be dropped in the one of the one or more slots.
- 23. (Previously Presented) The method of claim 16 wherein the configuration
 layout is representative of a physical layout of the product.
- 24. (Previously Presented) A method of visually configuring a product by placing
 one or more of a plurality of objects into a slot, the method comprising:

3	providing a product configuration layout to a client device for display within
4	a graphical user interface, the product configuration layout including
5	a slot for placement of one of the plurality of objects;
6	providing the plurality of objects to the client device for display within the
7	graphical user interface;
8	receiving, from the client device, a selection of one of the plurality of
9	selectable objects for placement within the slot;
10	causing the graphical user interface to show the selected selectable object
11	within the slot if the selected object can be placed in the slot withou
12	violating a configuration rule; and
13	causing the graphical user interface to indicate that the selected object
14	cannot be placed in the slot, if placing the selected object in the
15	selected slot would violate the configuration rule.
1	25. (Previously Presented) The method of claim 24, wherein providing a product
2	configuration layout and providing the plurality of selectable objects are
3	performed in one step.
1	26. (Previously Presented) The method of claim 24, wherein the slot is
2	predetermined.
1	27. (Previously Presented) The method of claim 24, wherein the slot is selected
2	from a plurality of slots included in the product configuration layout.

I	28. (Previously Presented) The method of claim 24, wherein the slot is selected
2	from a plurality of slots included in the product configuration layout, the
3	plurality of slots being representative of physical locations within the
4	product.
1	29. (Previously Presented) A method of configuring a product for purchase, the
2	method comprising:
3	selecting the product for purchase, the product having a plurality of
4	alternative configurations, the plurality of alternative configurations
5	being limited by a plurality of configuration rules;
6	viewing a first configuration of the plurality of alternative configurations
7	and a plurality of objects, within a graphical user interface, the
8	viewed first configuration including one or more slots within which
9	at least one of the plurality of objects may be placed;
10	specifying a second configuration of the selected product by selecting a
11	first of the plurality of objects for placement in a first of the one or
12	more slots, the placement of the first of the plurality of objects in the
13	first of the one or more slots being limited by a subset of the
14	plurality of configuration rules, the selection of the first of the
15	plurality of objects being made using the graphical user interface.

30. (Previously Presented) The method of claim 29, wherein the subset of the plurality of configuration rules is determined based on the first configuration.

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first of the one or more slots by dragging the first of the plurality of objects

to the first of the one or more slots, within the graphical user interface.

- 1 32. (Previously Presented) The method of claim 29, wherein the plurality of
- 2 alternative configurations includes a finite number of alternative
- configurations, the finite number being determined in part by the plurality
- 4 of configuration rules.
- 33. (Previously Presented) The method of claim 1, wherein the selection of one
- of the plurality of selectable objects affects a validity of a selection of
- another of the plurality of selectable objects and a selection of another of
- 4 the plurality of slots.
- 1 34. (Previously Presented) The method of claim 1, wherein the selection of one
- of the plurality of selectable objects occurred prior to the selection of one
- of the plurality of slots.
 - 35. (Previously Presented) The method of claim 16, wherein causing the
 - graphical interface to indicate that the selected object cannot be placed in

the selected slot occurs while attempting to place the selected object in

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the selected slot.